

## **REMARKS**

**Claims 68-92 are pending. Claims 68-92 are rejected. Claims 68, 72, 76 and 83-84 are amended herein. Claims 93-109 are new.**

**As discussed below, all of the claims are in condition for allowance. But if after considering this response, the Examiner does not allow all of the claims, then the Applicants' Attorney formally requests that the Examiner contact him to schedule and conduct a telephone interview before issuing a subsequent office action.**

### **§ 103(a) Rejection of Claims 68-72, 74, 77-92 Over Spagna et al. (U.S. Patent No. 6,587,837) And Further In View of Wyman (U.S. Patent No. 5,260,999)**

To establish a *prima facie* case of obviousness, an Office Action must demonstrate that all claimed elements are taught or suggested by proffered references. Section 2143.03 of the MPEP requires the “consideration” of every claim feature in an obviousness determination. To render a claim unpatentable, however, the Office must do more than merely “consider” each and every feature for this claim. Instead, the asserted combination of cited references must also teach or suggest *each and every claim feature*. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (emphasis added) (to establish *prima facie* obviousness of a claimed invention, all the claim features must be taught or suggested by the references).

The failure of an asserted combination to teach or suggest each and every feature of a claim remains fatal to an obviousness rejection under 35 U.S.C. § 103, despite any recent revision to the Manual of Patent Examining Procedure (MPEP). For example, in *In re Wada and Murphy*, Appeal 2007-3733, the BPAI specifically states that:

“When determining whether a claim is obvious, an examiner must make “a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art.” *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). Thus, “obviousness requires a suggestion of all limitations in a claim.” *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (*citing In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). Moreover, as the Supreme Court recently stated, “*there must be*

*some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added)).”

In sum, it remains well-settled law that obviousness requires **at least a suggestion of all of the elements of a claim**. See *In re Wada and Murphy*, citing *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) and *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)).

As currently presented, the present claims include elements that are not taught or suggested by *Spagna* and *Wyman*, either alone or in combination.

### **Claim 68**

Claim 68 has been amended in accordance with amendments suggested by Examiner in a telephonic interview that occurred on November 9th, 2009, wherein Examiner indicated that suggested amendments would put the claims in condition for allowance. For example, as suggested by Examiner, elements of Claims 74 and 75 have been incorporated into Claim 68. Accordingly, Applicants’ Attorney submits that Claim 68 is in condition for allowance.

### **Claims 69-72, 74, 77-92**

Claims 69-72, 74 and 77-92 depend from Claim 68 and are therefore at least allowable by dependency. Accordingly, Applicants’ Attorney submits that these claims are in condition for allowance.

### **§ 103(a) Rejection of Claims 73, 75, and 76 Over Spagna et al. In View of Wyman And Further In View Of Eichstaedt et al. (U.S. Patent No. 6,108,645)**

Claims 73, 75 and 76 depend from Claim 68 and are therefore at least allowable by dependency because Claim 68 is allowable for the reasons discussed above. Applicants’ Attorney therefore requests that the rejection of Claims 73, 75 and 76 be withdrawn.

### **New Claims 93-108**

Claims 93-108 depend from Claim 68 and are therefore at least allowable by dependency because Claim 68 is allowable for the reasons discussed above. Accordingly, Applicants' Attorney submits that these claims are in condition for allowance.

### **New Claim 109**

New Claim 109 is allowable at least because none of the cited references teach all the elements of Claim 109. For example, the cited references fail to teach modifying at least one of the user attributes to qualify for a license as recited in Claim 109.

Claim 109 is directed to a method for controlling digital content, where user demographic attributes can be modified to allow a user to qualify for access to the digital content. For example, if the end-user has less than 18 years of age, the rights broker 142 can determine that if the end-user's age attribute were changed, the rights broker 142 could grant the license to the consumer computer 120. "This may be the case where, for example, an end-user has recently turned 18 years of age, but the system has not updated the consumer information yet. (Specification, paragraph [0084])

The Advisory Action submits that *Wyman's* teaching of assignment of rights or reservation of rights is equivalent to a teaching of a modification of user attributes to allow a user to qualify for access to digital content. However, as defined by the present specification, user attributes as recited in Claim 109 relate specifically to demographic user information and not to assignment or reservation of rights as taught by *Wyman*.

Specifically, Paragraph [0035] of the present specification defines that:

Attributes include, but are not limited to, age of end-user, residence of end-user, form of payment employed by end-user, physical location of consumer computer 120, IP address of consumer computer 120, type of consumer computer 120 (e.g., server, desktop, laptop, portable, handheld, cellular phone, BlackBerry™, portable audio or video player, etc.), type of

content typically accessed by end user, content format (*e.g.*, text, audio, video, multi-media), content category (education, news, sports, entertainment, etc.), content topic (Abraham Lincoln, U.S. Presidents, San Diego, California, etc.), date, date range, content rating classification (*e.g.*, Parental Guidance for under 13 (PG-13), Restricted (R), premium content, standard content, 1-5 star ratings), etc.

Accordingly, user attributes, as used herein, relate to user demographic information, and not generally to rights that may be assigned to a given user. Therefore, *Wyman*, either alone or in combination with any other cited reference, fails to teach or suggest modification of user attributes as recited in Claim 109. Accordingly, Claim 109 is allowable for at least this reason.

In the event additional fees are due as a result of this amendment, the Commissioner is hereby authorized to charge any deficiency of fees submitted herewith, or credit any overpayment, to Deposit Account No. 07-1897.

**Additionally, if the present amendment does not put the claims in condition for allowance as indicated by Examiner, then she is respectfully requested to contact the Applicants' agent at (425) 455-5575 before issuing another office action.**

Dated this 29<sup>th</sup> day of December, 2009.

Respectfully submitted,

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